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09/782,677	02/12/2001	Mark C. Pace	19538-05784	8995
758 FENWICK & WEST LLP 7590 SILICON VALLEY CENTER 01/30/2009 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
EXAMINER STERRETT, JONATHAN G				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* MARK C. PACE and THOMAS W. COOK  
9

10 Appeal 2008-5444  
11 Application 09/782,677  
12 Technology Center 3600  
13  
14

15  
16 Decided: January 29, 2009  
17

18  
19 Before ANTON W. FETTING, DAVID B. WALKER, and  
20 BIBHU R. MOHANTY, *Administrative Patent Judges*.  
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL

23 STATEMENT OF THE CASE

24 Mark C. Pace and Thomas W. Cook (Appellants) seek review under  
25 35 U.S.C. § 134 of a final rejection of claims 1-75, the only claims pending in the  
26 application on appeal.

27 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

28 We AFFIRM.

The Appellants invented a two-way paging and rule-based scheduling system (Specification 1: Field of Invention).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A system for providing service to customers at service locations, each service location having a communication device adapted to communicate one or more events pertaining to a service event for a customer at the service location, the system comprising:

[1] a decisioning system

communicatively coupled to the communication devices to receive the events,

the decisioning system scheduling a primary service attendant from a plurality of service attendants

for servicing each event according to at least a value of the customer at the service location that generated the event;

[2] a communication system

communicatively coupled to the decisioning system to transmit a message to the primary service attendant selected for an event,

the message indicating the service location at which the event is to be serviced,

where the indicated service location is in a business establishment; and

[3] a plurality of message receivers,

used by the service attendants,

the primary service attendant using a message receiver to receive the message from the communication system.

1 This appeal arises from the Examiner's Final Rejection, mailed February 15,  
2 2006. The Appellants filed an Appeal Brief in support of the appeal on August 10,  
3 2006. An Examiner's Answer to the Appeal Brief was mailed on October 27,  
4 2006. A second Appeal Brief was filed on December 24, 2006.<sup>1</sup> A Reply Brief  
5 was filed on December 27, 2006.

6 PRIOR ART

7 The Examiner relies upon the following prior art:

Boushy	US 6,003,013	Dec. 14, 1999
McDonough	US 6,070,142	May 30, 2000
Acres	US 6,257,981 B1	Jul. 10, 2001

8 REJECTIONS

9 Claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66,  
10 68-71, and 75 stand rejected under 35 U.S.C. § 102(e) as anticipated by  
11 McDonough.

12 Claims 3-6, 11, 22, 25-28, 33, 44, 48-51, 62-65, 67, 72, and 73 stand rejected  
13 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Acres.

14 Claims 15, 16, 37, 38, and 74 stand rejected under 35 U.S.C. § 103(a) as  
15 unpatentable over McDonough and Boushy.

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<sup>1</sup> Generic references to the Appeal Brief in this Decision refer to the December 24, 2006 filing.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66, 68-71, and 75 under 35 U.S.C. § 102(e) as anticipated by McDonough.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 3-6, 11, 22, 25-28, 33, 44, 48-51, 62-65, 67, 72, and 73 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Acres.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 15, 16, 37, 38, and 74 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Boushy.

The pertinent issue turns on whether McDonough describes transmitting a message to a service attendant, the message indicating the service location at which the event is to be serviced, where the indicated service location is in a business establishment.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*McDonough*

01. McDonough is directed to a customer call center connecting any customer to any sales and service resource through any access method at any time from any customer location (McDonough 1:26-30).
02. Computer telephone integration (CTI) is a technology platform that merges voice and data services at the functional level and combines voice and data to form a foundation to support business applications, seamlessly combining functions from both the telephony world and the computing world (McDonough 1:43-49).
03. McDonough describes applying CTI to business establishments. Businesses also benefit from the use of CTI. For example, the benefits of CTI to business includes prompter and more accurate response to inquiries, orders, and service requests, personalized attention and efficient problem resolution, improved customer and prospects access to information about new products and services, increased number of services available and extended hours of operation (McDonough 2:33-39).
04. Upon obtaining all relevant available requirements information McDonough's routing application accesses resource profiles to find resources with the appropriate skills. A specific resource will then be

selected based on resource availability, skill profiles, and load balancing (McDonough 8:5-10).

05. McDonough's routing engine notifies the voice response unit (VRU) with the appropriate call treatment and routing authorization once a resource is selected. The VRUs then send the call to determine the appropriate employee and phone (McDonough 8:22-26).

06. As a contact progresses, the VRU, the employee workstation, the web server, and other devices continually interact with a context manager. Contacts may be transferred between resources many times during the course of a call and this transfer activity is coordinated by the context manger and the routing engine (McDonough 8:48-56).

07. McDonough's routing rules are the step-by-step instructions which combine the routing components to identify what resource will receive a particular contact. Skills based routing methodology uses the skills and experience of each resource. The skills and experience of each resource is then matched against the requirements and characteristics of a particular contact to assign any type of sales and service resource to the contact. Contacts can be assigned to any resource that has the skills required for the contact (McDonough 11:65 – 12:7).

08. To remain competitive, businesses must retain their most profitable customers and pro-actively increase customer profitability. McDonough does this by segmenting customers and allocating resource levels to each to so as to deliver the desired customer experience (McDonough 12:33–38).

09. Customers are routed to specially trained cross-sale specialists and/or customer interaction technology resources may be directed to issue cross sell messages to a customer when unique cross-sale opportunities are identified (McDonough 12:46-52).

*Acres*

10. Acres is directed to controlling gaming devices interconnected by a network (Acres 1:11-13).

*Boushy*

11. Boushy is directed to systems for tracking customer activity (Boushy 1:16-17).

*Facts Related To The Level Of Skill In The Art*

12. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, decision systems, and customer support systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).



*Facts Related To Secondary Considerations*

13. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Claim Preamble*

2  
3 “[A] claim preamble has the import that the claim as a whole suggests for it.”  
4 *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d  
5 615, 620 (Fed.Cir. 1995). If the claim preamble, when read in the context of the  
6 entire claim, recites limitations of the claim, or, if the claim preamble is “necessary  
7 to give life, meaning, and vitality” to the claim, then the claim preamble should be  
8 construed as if in the balance of the claim. *Kropa v. Robie*, 187 F.2d 150, 152  
9 (CCPA 1951). “If, however, the body of the claim fully and intrinsically sets forth  
10 the complete invention, including all of its limitations, and the preamble offers no  
11 distinct definition of any of the claimed invention's limitations, but rather merely  
12 states, for example, the purpose or intended use of the invention, then the preamble  
13 is of no significance to claim construction because it cannot be said to constitute or  
14 explain a claim limitation.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d  
15 1298, 1305 (Fed. Cir. 1999).

16  
17 *Anticipation*

18 “A claim is anticipated only if each and every element as set forth in the claim  
19 is found, either expressly or inherently described, in a single prior art reference.”  
20 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir.  
21 1987). “When a claim covers several structures or compositions, either generically  
22 or as alternatives, the claim is deemed anticipated if any of the structures or  
23 compositions within the scope of the claim is known in the prior art.” *Brown v.*  
24 *3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). “The identical invention must be  
25 shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki*  
26 *Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged

as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[ (1) ] the scope and content of the prior art are to be determined; [ (2) ] differences between the prior art and the claims at issue are to be ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field of  
2 endeavor at the time of invention and addressed by the patent can provide a reason  
3 for combining the elements in the manner claimed.” *Id.* at 1742.

4 ANALYSIS

5 *Claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66, 68-*  
6 *71, and 75 rejected under 35 U.S.C. § 102(e) as anticipated by McDonough.*

7 The Appellants argue these claims as a group.

8 Accordingly, we select claim 1 as representative of the group.  
9 37 C.F.R. § 41.37(c)(1)(vii) (2007).

10 The Examiner found that McDonough anticipated claim 1 (Answer 3-5). The  
11 Appellants contend that McDonough does not describe dispatching a service  
12 attendant to a location in a business establishment where a customer is located  
13 (Brief 8: First full ¶). In particular, the Appellants contend that McDonough  
14 provides service at remote rather than business locations (Brief 8: Bottom ¶).

15 The Examiner responds that the Specification does not define a business  
16 establishment, and that the claim only calls for an indicated service location being  
17 a business establishment in any event. The Examiner found that the indication of a  
18 service location occurs in a customer call center in McDonough and that a  
19 customer call center is itself a business establishment (Answer 17-18). The  
20 Appellants contend McDonough’s customers are not in the call center (Reply Br.  
21 1:¶ I); the Examiner is misconstruing the claim limitation (Reply Br. 3:¶ II); and  
22 McDonough does not dispatch service attendants (Reply Br. 5: ¶ III).

23 We agree with the Examiner. There is no contention regarding whether  
24 McDonough describes the required decisioning system to schedule staff for

servicing events, communication system for transmitting messages to the staff, and message receivers to receive the messages and McDonough clearly describes these limitations (FF 04 - 09). Independent claim 1 requires transmitting a message to a service attendant, the message indicating the service location at which the event is to be serviced, where the indicated service location is in a business establishment. The remaining independent claims 23, 45, 46, and 75 have similar limitations.

McDonough describes a call center where customers call and are connected to any service resource required (FF 01). Thus, the service location, which is simply the location at which service occurs, is where the service resource is applied. As the Examiner found, in a call center, a service resource is applied electronically within the call center, and a call center is a business establishment. McDonough's service resources are thus the service attendants as claimed that receive messages via McDonough's routing system to respond to a particular customer contact within the call center.

Further, the nature of services in a call center is that service is done by telecommunication. Telecommunication transmits information between where a service provider is located and a customer is located, and thus service is performed at both the service provider and customer locations simultaneously. Therefore, service is provided at both the call center and at the customer site in McDonough. Also, McDonough also describes how some of the customers are themselves located at business establishments (FF 03).

As to customers being in the service location, only the claim preamble recites this, and whether customers are at a service location does not affect the structure in the apparatus claims or the steps in the method claims. Thus, customers within a

service location are mere field of use limitations afforded no patentable weight.  
*Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999).

Finally as to dispatching of service providers, the word dispatch is not found in any of the claims, but McDonough's routing system performs the dispatching of its service resources (FF 04).

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66, 68-71, and 75 under 35 U.S.C. § 102(e) as anticipated by McDonough.

*Claims 3-6, 11, 22, 25-28, 33, 44, 48-51, 62-65, 67, 72, and 73 rejected under 35 U.S.C. § 103(a) as unpatentable over McDonough and Acres.*

These claims introduce requirements regarding the attributes of a customer, for which the Examiner applied Acres. The Appellants argue that these claims are patentable for the same reasons as claim 1 (Appeal Br. 10: ¶ II), which we found unpersuasive *supra*. The Appellants also contend there is no motivation to modify McDonough because McDonough's call center would not be used to dispatch service attendants (Appeal Br. 12: ¶ IV). The Examiner responds that the claims do not have a limitation of dispatching service attendants (Answer 19).

We agree with the Examiner. None of the claims recite dispatching. The Appellants agree with this, but argue that the claim features enable dispatching (Reply Br. 5-6: ¶ III). This argument is simply not commensurate with the breadth of the claims. The claims do not require dispatching.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 3-6, 11, 22, 25-28, 33, 44, 48-51, 62-65, 67, 72, and 73 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Acres.

*Claims 15, 16, 37, 38, and 74 rejected under 35 U.S.C. § 103(a) as unpatentable over McDonough and Boushy.*

These claims introduce gaming machine limitations for which the Examiner applies Boushy. The Appellants argue that modifying McDonough according to claim 1 would destroy a fundamental principal of McDonough, *viz.* connecting service providers via a call center (Appeal Br. 11: ¶ III). The Appellants go on to elaborate that their claims require dispatching. Thus, this is a repetition of the argument regarding dispatching that we found unpersuasive *supra*. The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 15, 16, 37, 38, and 74 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Boushy.

#### CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66, 68-71, and 75 under 35 U.S.C. § 102(e) as anticipated by McDonough.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 3-6, 11, 15, 16, 22, 25-28, 33, 37, 38, 44, 48-51, 62-65, 67, and 72-74 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 2, 7-10, 12-14, 17-21, 23, 24, 29-32, 34-36, 39-43, 45-47, 52-61, 66, 68-71, and 75 under 35 U.S.C. § 102(e) as anticipated by McDonough is sustained.
- The rejection of claims 3-6, 11, 22, 25-28, 33, 44, 48-51, 62-65, 67, 72, and 73 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Acres is sustained.
- The rejection of claims 15, 16, 37, 38, and 74 under 35 U.S.C. § 103(a) as unpatentable over McDonough and Boushy is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED



Appeal 2008-5444  
Application 09/782,677

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